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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/898,853 07/25/97 YAMAGISHI

H Q45980

EXAMINER

QM12/0213

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GORDON, R

ART UNIT

PAPER NUMBER

3711

25

DATE MAILED:

02/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/898,853

Applicant(s)

Yamagishi et al.

Examiner

Raeann Gorden

Group Art Unit

3711



☒ Responsive to communication(s) filed on Nov 21, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-12 is/are allowed.

☒ Claim(s) 13-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit:

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not substantially disclose a third layer on the core of the golf ball. There is an option of providing additional layers (spec 9 line 5) but there are no specific details given regarding the characteristics. Particularly there is no mention of the Shore D hardness being less than the second layer (claim 13) or the thickness (claim 15). The shore D hardness of the core inner layer is not lower than 20 and the diameter is not lower than 20 mm according to the specification (p 6 line 31 and p 7 line 1) yet, the limitations of claims 14-15 fall beneath these values. Furthermore, there is no mention of the specific gravities in claim 16 or the materials in claim 18.

Art Unit:

Allowable Subject Matter

3. Claims 1-12 are allowed.

Response to Arguments

4. Applicants have advanced two arguments with regard to the rejection of claims 13-19 under 35 U.S.C. 112 first paragraph.

5. Applicants' first argument is based on the premise that although two core layers and two cover layers were originally disclosed in the instant application, the innermost cover layer may nevertheless be considered simply an outermost core layer. Applicants state that there is no substantial difference between what has been disclosed as an inner cover layer, and, what the patent with which applicants seek to provoke an interference, discloses as an outer core layer, citing similar materials and compositions in the compared layers. However, this position is at odds with that taken by the applicants in paper 6 where applicants argued that prior art showing a three piece core and a cover is "*completely distinguishable*" from the ball of the applicants' claims, (emphasis added). (See paper 6 remarks pages 4-6). These remarks were made in an attempt to overcome a prior art rejection. Under file wrapper estoppel doctrine applicants are estopped from now arguing that the inner cover layer may be considered an outer core layer or vice-versa.

6. Applicants' second argument is that based on the disclosure that his core layer consists of at least two layers, a third layer was disclosed. With this statement the office has no dispute.

Art Unit:

However, claim 13 claims a core with three core layers and a cover. As applicants' original disclosure also states that the cover consists of at least two layers, applicant's claimed cover must be read to include the at least two cover layers. Because the cover must contain at least two layers it is the innermost layer of the cover which must have the attributes now given to the outermost core layer in claims 13-19. Although applicants did originally disclose three core layers, nowhere were any properties of this third core layer with the required two layer cover given. For this reason the balance of applicants' arguments pertaining to the dependent claims 14-19 and their limitations also fail.

7. In summary applicants' inner cover layer was disclosed as such and not as a core layer. Cores and covers are different elements of a golf ball with different purposes. Unless a core and cover layer are identical, (same material, thickness, method of forming/bonding^{ex}) and differ in name only, the presumption, absent disclosure to the contrary, must be that they are distinguishable from one another. Applicants' inner cover layer is constructed of a cover layer material and is formed of a different material than that of the outer core layer of the patent with which applicant seeks to provoke an interference. Furthermore, applicants have stated on the record in attempting to overcome a prior art rejection that core layers are completely distinguishable from cover layers.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit:

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is (703) 308-8354. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on 703-308-1310. The fax number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MSG
February 9, 2001


Mark S. Graham
Primary Examiner